

Amendment to the Drawings:

There are none.

REMARKS/ARGUMENTS

Drawings

The Examiner has accepted the drawings, and Applicant appreciates the same.

Claim Rejections – 35 USC § 102

The Examiner has rejected claims 1-9 as being anticipated by Scrivens ('518). The Applicant respectfully requests that the Examiner reconsider the rejections based on the arguments and points submitted below, and where applicable, based on the amendments to the claims submitted above.

The Scrivens '518 reference specifically does not establish a *prima facie* case of anticipation under Section 102.

The Scrivens '518 reference is very limited to a receiver 12 which is “a single, fixed frequency device receiver 12 can be pre-tuned during manufacture to reduce manufacturing costs and to reduce errors in the system. By avoiding multiple frequencies, receiver 12 substantially eliminates problems due to interference, inaccurate operation, mechanism failure, and other reliability issues”. (Column 3, lines 41-46, Scrivens '518). Therefore it is clear that Scrivens '518 only discloses a single frequency device that is manufactured as such to reduce manufacturing costs, and it is a “fixed” frequency device.

Scrivens '518 further distinguishes itself from tunable receivers, noting the higher cost, stating at Column 1, lines 33-39:

...Although the radio receivers detecting such broadcast signals are relatively compact, such receivers are tunable so that the frequency of the broadcast signal can be adjusted.

This feature significantly increases the receiver cost and creates problems for the user if the tuning control is not accurately adjusted to the desired frequency. Additionally, such systems can experience significant signal interference due to the multitude of frequencies broadcast within the permitted bandwidth [Emphasis added]

Embodiments of this invention as claimed, on the other hand, include, a tuner or receiver that may be tuned or set to any one of a number of different frequencies or stations, but for purposes of promotion, are set or locked to one of that number of possible stations. This allows more flexibility in the setting of the frequency.

In other embodiments, it is not the receiver of this invention that is limited or locked, but instead the audio output or even the outer encasement. This allows a particular radio station owner to receive a large volume of the radios and pre-set or pre-tune them in lots, some to one station they own and other lots to other stations it owns. Scrivens '518 on the other hand is locked into one at manufacture.

Furthermore, if a single frequency, fixed frequency device such as Scrivens '518 is set as such during manufacture, other minor factors and variations may render it slightly out of tune under local radio broadcast conditions, or even variations of conditions, with no way to re-tune them because they are a single frequency device.

This invention on the other hand may be more particularly tuned in the field or in the broadcast range of the particular radio station.

The applicant submits that Scrivens '518 does not anticipate this invention for at least the following reasons:

1. Scrivens '518 is not known or capable of performing the function of this invention, nor does it teach the disclosure of this invention. Scrivens '518 is directed to a fixed frequency and single frequency device to save on cost and expense, and to direct it toward an event-based system. Scrivens '518 is not therefore capable of performing the function of this invention, and does not state this function.

There is no anticipation by a prior patent not known or recognized as being capable of performing the function of the patented device, but rather the prior patent must itself do the teaching. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 221 U.S.P.Q. 385 (1984); Edstrom-Carson & Co. v. Onsrud Machine Works, Inc., 129 U.S.P.Q. 457.

2. Scrivens '518 does not disclose the purpose, means or mechanism that this invention discloses – the Examiner had not identified where in Scrivens '518 or any other reference, in which there is a multi-frequency receiver. There

is no anticipation where a reference does not disclose the purpose, means and mechanism for accomplishing the instant invention but rather is restricted to a limited and different means. Sperry Products, Inc. V. Aluminum Company of America, 120 U.S.P.Q. 362.

3. Scrivens '518 does not solve the problems this invention solves and there is no discussion of the same problems or solutions in Scrivens. There is no anticipation if a prior patent does not solve the problem(s) which the subsequent patent successfully solves. Technical Development Corporation v. Servo Corporation of America, 125 U.S.P.Q. 133.

4. Scrivens '518 does not disclose each and every element of this invention, as required for a *prima facie* case of anticipation, and as stated more fully above. Scrivens '518 is directed to a single frequency, fixed frequency receiver, and the Examiner has not pointed to anything in Scrivens '518 which discloses a multi-frequency, receiver. There is no anticipation if the reference does not disclose each and every element of the claimed invention. SSIH Equipment S.A. v. United States International Trade Commission, 718 F.2d 365, 218 U.S.P.Q. 678 (1983).

Claim Rejections – 35 USC § 103

The Examiner has rejected claims 10-53 as being obvious, primarily over Scrivens ('518), in view of Okamoto '631. The Applicant respectfully requests that the Examiner reconsider the rejections based on the arguments and points

submitted below, and where applicable, based on the amendments to the claims submitted above.

The Applicant's arguments and reasons why the Examiner has not met his burden to set forth a *prima facie* case for obviousness, can generally be summarized as follows:

1. There is nothing in the Scrivens '518 or in Okamoto '631 patent reference which teaches or suggests that it can or should be combined with the other.

2. The Scrivens '518 reference is directed to a fixed frequency, single frequency receiver, and not one which wherein a multi-frequency radio signal receiver is secured relative to the outer encasement, the radio signal receiver being capable of receiving a plurality of frequencies of radio signals.

3. The combination of references does not include all the elements of the claims in question, there being no promotions or advertisements in the encasements or defined by the encasement in Scrivens or in Okamoto, as set forth above with respect to the anticipation rejection.

4. The proposed modification or combination of Scrivens with Okamoto changes the principle of operation of the Scrivens reference, and therefore the teachings of the references are not sufficient to render the claims *prima facie* obvious.

The arguments above apply to each of the independent claims, and therefore to the claims upon which they depend, and therefore the Applicant asserts that all the claims are in a position for allowance.

Applicant requests the Examiner reconsider the rejection because there is nothing in the Scrivens '518 Patent reference which suggests that it be combined with Okamoto or any other similar reference. The Okamoto '631 patent is directed to digital radio and using information which may be placed in the digital signal to identify one of many stations it may be tuned into at a given time.

Furthermore, there is nothing in the Okamoto reference which suggests the desirability of the combination and therefore the Examiner has not met the minimum required showing for *prima facie* obviousness.

The proposed modification to the Okamoto patent renders it unsatisfactory for its intended use. If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

The proposed modification or combination of Scrivens with Okamoto changes the principle of operation of the Scrivens reference, and therefore the teachings of the references are not sufficient to render the claims *prima facie* obvious. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

In the U.S. Court of Appeals for the Federal Circuit case of *In Re: Lee*, 61 U.S.P.Q. 2d 1430, decided January 18, 2002, the Federal Circuit held:

...Thus, when they rely on what they assert to be general knowledge to negate patentability, that knowledge must be articulated and placed on the record. The failure to do so is not consistent with either effective administrative procedure or effective judicial review. The Board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies.

The examining attorney has therefore failed to meet the requirement to set forth with specificity the general knowledge in the art to enable a finding that the person having ordinary skill in the art would make such combination.

As the PTO recognizes in MPEP 2142:

The legal concept of *prima facie* obviousness is a procedural tool of examination which applies broadly to all arts. It allocates who has the burden of going forward with production of evidence in each step of the examination process... The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of non-obviousness... The

initial evaluation of *prima facie* obviousness thus relieves both the Examiner and Applicant from evaluating evidence beyond the prior art and the evidence in the specification as filed until the art has been shown to suggest the claimed invention.

MPEP 2143.01 provides:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re: Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

The Federal Circuit has several times expressly addressed the issue of how to evaluate an alleged case of *prima facie* obviousness to determine whether it has been properly made. Thus, *In re: Geiger* stated in holding that the PTO "failed to establish a *prima facie* case of obviousness:

Obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *ADC Hospital Systems, Inc. V. Monteffore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

Prior Art Made of Record and Not Relied Upon

The Applicant notes the prior art made of record but not relied upon and asserts that for the reasons set forth above, the claims are allowable over the art made of record.

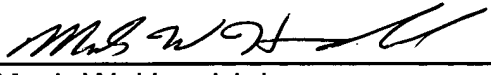
Conclusion

Applicant is submitting a Request for Continued Examination (RCE) herewith as well as any required fees.

Applicant therefore submits Claims 1-53 are in a position to proceed to allowance.

Respectfully submitted,

Dated: 2/25/05

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Attachments: There are none.